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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,639	12/17/2001	Sang-Uuk Song	678-715 (P9743)	4279

7590 07/14/2004

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EXAMINER

PEACHES, RANDY

ART UNIT PAPER NUMBER

2686

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/023,639	SONG, SANG-UUK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Randy Peaches	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/24/2003</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Priority*

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. ***Claims 1, 2-7*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al (U.S. Patent Number 6,148,197) in view of Blakeney, et al (U.S. Patent Number 6,085,085).

Regarding ***claim 1***, Bridges et al discloses a method of providing a roaming service for a mobile communication terminal, the method comprising the steps of:

- receiving a system parameter message including a system ID from a base station by a mobile communication terminal in an idle state. See columns 8 and 9 lines 50-55 lines 52-55, respectively;
- determining whether or not the base station participates in a roaming service by utilizing the system ID. See column 12 lines 20-34;

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- maintaining the idle state if in the affirmative. See column 12 lines 35-38;

However, Bridges et al does not disclose where the said mobile terminal will enter an out-of-service (OOS) state if in the negative.

Blakeney et al discloses in columns 6 and 7 lines 63-67 lines 35-40, respectively, where if it is determined to be a negative system, the system will power down, which reads on claimed "OOS", until a later predetermined time. Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Bridges et al (U.S. Patent Number 6,148,197) to include Blakeney, et al (U.S. Patent Number 6,085,085) in order provide a means for the said mobile communication terminal to go in an out of service state when a non-registered service provider is determined in a list of roaming service providers.

Regarding **claim 3**, according to **claim 1**, wherein Bridges et al discloses in column 9 lines 26-33, the system parameter message is transmitted in accordance with IS-95 standard criteria.

Regarding **claim 4**, according to **claim 1**, Blakeney et al disclose wherein the step of determining whether or not the base station participates in a roaming service is performed by comparing the system ID with a preferred roaming list stored in a memory of a mobile communication terminal. See column 2 lines 28-31.

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Regarding **claim 5**, according to **claim 4**, Blakeney et al disclose wherein the preferred roaming list includes system IDs that can provide the mobile communication terminal with a roaming service. See column 2 lines 28-31.

Regarding **claim 6**, according to **claim 4**, Blakeney et al disclose wherein the preferred roaming list includes system IDs that cannot provide the mobile communication terminal with a roaming service. See column 2 lines 28-31.

Regarding **claim 7**, according to **claim 4**, Bridges et al disclose wherein the mobile communication terminal entered into the OOS state displays "an OOS state" message on a display screen of the mobile communication terminal. See column 11 lines 8-15.

2. **Claims 2 and 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al (U.S. Patent Number 6,148,197) in view of Blakeney, et al (U.S. Patent Number 6,085,085) as applied to claim 1, 3-7 above, and further in view of Huang et al. (U.S. Patent Number 6,363,251 B1).

Regarding **claim 2**, as the combination of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) are made, the combination according to **claim 1**, does not disclose wherein the system parameter message is broadcasted to all mobile communication terminals through a paging channel.

Huang et al discloses in column 6 lines 35-42, where the service messages, which reads on claimed "system parameter message", is broadcasted to the mobile stations through a paging channel.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) to further include Huang et al. (U.S. Patent Number 6,363,251 B1) to allow the information pertaining to the service providers available and not available during roaming is able to be broadcasted to mobile terminal in a channel capable of not disrupting other valuable services.

Regarding **claims 9 and 10**, Bridges et al discloses a roaming method for a mobile communication terminal that stores a preferred roaming list consisting of system IDs that participate in a roaming service, the method comprising the steps of:

- maintaining the idle state if the system ID is included in the stored preferred roaming list. See column 12 lines 35-38; and

However, Bridges et al does not disclose where entering an OOS state if the system ID is not included in the stored preferred roaming list.

Blakeney et al discloses in columns 6 and 7 lines 63-67 lines 35-40, respectively, where if it is determined to be a negative system, the system will power down, which reads on claimed "OOS", until a later predetermined time.

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Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Bridges et al (U.S. Patent Number 6,148,197) to include Blakeney, et al (U.S. Patent Number 6,085,085) in order <sup>to</sup> provide a means for the said mobile communication terminal to go in an out of service state when a non-registered service provider is determined in a list of roaming service providers.

The combination of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) further does not disclose where receiving a system parameter message including a system ID from a base station through a paging channel by the mobile communication terminal in an idle state.

Huang et al discloses in column 6 lines 35-42, where the service messages, which reads on claimed "system parameter message", is broadcasted to the mobile stations through a paging channel.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) to further include Huang et al. (U.S. Patent Number 6,363,251 B1) to allow the information pertaining to the service providers available and not available during roaming is able to be broadcasted to mobile terminal in a channel capable of not disrupting other valuable services.



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3. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al (U.S. Patent Number 6,148,197) in view of Blakeney, et al (U.S. Patent Number 6,085,085) as applied to **claims 1, 3-7** above, and further in view of Weideman et al. (U.S. Patent Number 6,072,768).

Regarding **claim 8**, as the combination of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) are made, the combination according to **claim 1**, fails to teach wherein the mobile communication terminal entered into the OOS state displays "an OOS state" on the display screen if user demands an outgoing call.

Weideman et al. teaches in column 9 lines 11-17, where the user operates the user terminal; however, if service is lost, a "No Service" message appears, which reads on claimed "OOS".

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combined teachings of Bridges et al (U.S. Patent Number 6,148,197) and Blakeney, et al (U.S. Patent Number 6,085,085) to further include Weideman et al. (U.S. Patent Number 6,072,768) in order for a message representing a "No Service" if a user of a said mobile terminal attempts to place a call when service is not available.

### **Conclusion**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches  
July 8, 2004

  
CHARLES APPIAH  
PRIMARY EXAMINER